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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/878,908	06/19/1997	KARL-LUTZ LAUTERJUNG	VAS.0002US	8837

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TROP PRUNER & HU, PC
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

EXAMINER

PREBILIC, PAUL B

ART UNIT	PAPER NUMBER
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3738

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

08/878,908

Applicant(s)

LAUTERJUNG, KARL-LUTZ

Examiner

Paul B. Prebilit

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32,65-73,75-79,81 and 82 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32,65-73,75-79,81 and 82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Withdrawal of Finality

Upon review of the amendment filed April 2, 2007 and in consideration of the arguments made in the interview dated April 10, 2007, the Examiner decided to withdraw the previous Final Office action in favor of this Final Office action.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: With regard to claims 32 and 75-79, the language requiring "substantially continuous contact with another winding for a complete turn of a given winding" does not have antecedent basis from the specification. Furthermore, in claims 67-69, the language requiring that a "cross-section taken through any portion of said ring along a line that is parallel to said longitudinal axis such that no matter where said cross-section is taken on the ring, said cross-section of said windings is substantially circular" does not have antecedent basis from the specification either.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Art Unit: 3738

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 32 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 58 of copending Application No. 10/832,159. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 58 appears to be read on by copending claim 32 such that it is considered clearly obvious in view thereof.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 65 and 66 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 48 of copending Application No. 10/835,159. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 65 and 66 are read on by claim 48 such that they are clearly obvious in view thereof.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 69 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 7 of copending Application No. 10/832,159. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 69 is read on by claim 7 such that it is clearly obvious in view thereof.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Upon review of the copending related application list provided by the Applicant on pages 11 and 12 of the November 13, 2006 response, the Examiner determined that claim 32 of the present application conflicts with claims 11 and 12 of copending application 11/496,162. The second section of claim 32 is equivalent to the first prosthesis of claims 11 and 12, the third prosthesis of claim 32 is equivalent to the second prosthesis of claims 11 and 12 and the fourth prosthesis corresponds to the third prosthesis of claim 12. However, in order to advance prosecution, a double patenting rejection will not be given at this time.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 65-73, 75-79, and 81-82 are rejected under 35 U.S.C. 102(e) as being anticipated by Dwyer et al (US 5,843,167). Dwyer anticipates the claim language where the diameter of at least one winding as claimed is that of 6 windings that are on opposite sides of the anchor (14R) see Figure 35; see the abstract and figures. Figures 35-38 illustrate merely the anchor portion of the implant where radially overlapping

Art Unit: 3738

windings of wire form part of the resilient elements (anchors) of Dwyer. The anchors of Figures 35-38 are used as part of the distal anchor (14R); see Figures 35-38 and column 16, lines 36-59. The terminology "radially overlapping" is along the radius of the wire of the winding not the radius of the winding.

With regard to claim 65, 66 and 69, the bundle of windings of a single strand of resilient metal wire is not viewed as being limited to only of a single strand. Rather, the bundle could comprise two strands of wire (6 windings in all) positioned on opposite sides of the resilient element or anchor (14R) of Dwyer.

With regard to claims 70-73, 81, and 82, the claims at most require a part of the graft is adapted to extend past an intersection of blood vessels. However, this language does not preclude having the entire graft located past the intersection. Furthermore, with regard to claim 81, the part engaging the blood vessels can be the outer parts of surfaces of the respective elements. For this reason, the claim language is fully met.

Response to Arguments

Applicant's arguments filed April 2, 2007 have been fully considered but they are not persuasive.

In response to the argument that there is no evidence or reasoning provided for the Section 112, first paragraphs rejections, the Examiner has withdrawn the rejections as there appears to be support for the claim language of the November 2006 claim amendment. However, this language does not have proper antecedent basis from the specification.

With regard to the prior art rejections, the Examiner asserts that the claim language is still read on by Dwyer when read more broadly than Applicant has interpreted it. In particular, the type of diameter of the windings is not specified and it can be taken across a plurality of windings on opposite sides of the ring.

With regard to the traversal of claim 70, the Applicant assumes that the device must be positioned in the same manner as that disclosed in the specification to meet the claim language. However, when the Dwyer stent-graft is placed entirely past the intersection, then the claimed intended use functional language is fully met. In other words, the entire graft that includes "a part" can be positioned past the intersection of a first blood vessel and a second blood vessel. The claim language does not require that one part is on one side of the intersection and another part is on the second side of the intersection as the Applicant apparently interprets it.

With regard to claim 81, the part engaging the blood vessels can be the outer part or surfaces of the respective elements. For this reason, the claim language is fully met.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

Art Unit: 3738

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Paul B. Prebilic
Primary Examiner